

#### REMARKS

This amendment is in response to the Office Action dated June 15, 1995. Reconsideration of the rejected claims in view of this amendment is respectfully asked.

The specification has been amended to correct inadvertent errors and omissions therein.

The draftperson's objections to the drawings are noted. Formal drawings will be submitted upon allowance of a claim.

Submitted herewith is a copy of the drawing sheet indicating in red proposed changes to correct inadvertent reference numeral and section line omissions. Approval of these drawing changes is respectfully asked.

Claims 4-6 and 17 are rejected under 35 U.S.C. §112 as being indefinite in that the meaning of the phrase "retaining member...for cooperation with said inner end surface" in claims 4 and 17 is allegedly unclear.

Claims 4 and 17 have been cancelled and the subject matter thereof has been incorporated by amendment in independent claims 1 and 15, respectively. The amended claim language recites that the retaining member is "friction fitted" in the bore and further recites "said retaining member and said inner end surface cooperating to retain said magnet therebetween." It is believed that this language is clear and definite in reciting cooperation between the retaining member and the inner end surface of the bore to retain the magnet in place.

Claims 1, 3-5, 9-15 and 17-20 are rejected under 35 U.S.C. §103 as being unpatentable over U.S. patent no. 4,663,998 to Parsons et al., in view of U.S. patent nos. 3,007,504 to Clark and 2,806,396 to Miller. Parsons et al. discloses a wrench socket with a split retaining ring for retaining a magnet in place. Clark discloses a magnetic bit-retaining tool and Miller discloses a magnetic socket with a partially-encapsulated permanent magnet.

A significant aspect of the invention is the provision of a discrete retaining member which is press-fitted in the bore outboard of the permanent magnet. This permits the use of various sized magnets which do not have to be precisely sized for press-fitting in the bore, thereby avoiding the stress occasioned by the press-fitting operation. It also permits the use of a straight bore which does not have to have special grooves or the like formed therein to accommodate a retaining member. In order more clearly to bring out this distinguishing aspect of the invention, each of the independent claims 1 and 15 has been amended to specify:

"said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet, said retaining member and said inner end surface cooperating to retain said magnet therebetween."

No such arrangement is disclosed or suggested by the cited references. Accordingly, it is submitted that, as amended herein, each of independent claims 1 and 15 and the claims dependent thereon are now patentable over the art of record.

Claims 4 and 17 have been cancelled as redundant in view of the amendments to the base independent claims and claims 5 and 6 have been amended to change the dependency thereof accordingly.

Claim 6, which is now dependent on claim 1, additionally recites that the retaining member is generally bowl-shaped, being convex toward said magnet. This arrangement serves to enhance the cushioning and retaining functions of the retaining structure and, therefore, affords an additional reason for the allowance of claim 6, since this arrangement is not disclosed or suggested in the art of record.

Claim 9, which is dependent on claim 1, additionally recites a cushioning member. Claim 9 has been amended to specify that the cushioning member is "discrete from said magnet" and is disposed between the magnet and the inner end surface of the body. The use of such a discrete cushioning member along the inner surface of a permanent magnet is not disclosed or suggested in the art of record and, therefore, this affords an additional reason for the allowance of claim 9.

Claims 2 and 16 are rejected under 35 U.S.C. §103 as being unpatentable over Parsons et al. in view of Clark and Miller as applied to claim 1, and further in view of U.S. patent no. 5,266,914 to Dickson et al., which is cited for a teaching of a neodymium magnet. Claims 2 and 16 are, respectively dependent on claims 1 and 15 and are, therefore, believed to be allowable

for the same reasons as the base independent claims, since Dickson et al. neither discloses nor suggests the discrete, press-fitted retainer recited in the independent claims.

Claims 7 and 8 are rejected under 35 U.S.C. §103 as being unpatentable over the references being applied to claim 1, and further in view of U.S. patent no. 3,165,950 to Gooley et al., which is cited for a teaching of a retaining member which may be formed of metal or resilient material. Claims 7 and 8 are dependent on claim 1 and are, therefore, believed to be allowable for the same reasons as set forth with respect to claim 1, since Gooley et al. neither discloses nor suggests a discrete, press-fitted retaining member for retaining a permanent magnet in place in a bit holder.

New claim 21 is a modified version of original claim 13 in independent form. In particular, claim 21 recites that the magnet has peripheral side and first and second end surfaces, and further recites "encapsulation material substantially surrounding said magnet and covering the side and end surfaces thereof." The resulting structure both provides an interference fit of the magnet in the bore and also provides cushioning between the magnet and the inner end surface of the body and the associated bit. It is submitted that no such arrangement is disclosed or suggested by the art of record.

Miller discloses a partially encapsulated magnet. However, the outer surface of the magnet in Miller is not covered by the

encapsulation material. Certain magnets, such as neodymium magnets, are quite brittle and it is important to cover the magnet completely, so that in the event it breaks in use, the encapsulation will retain any broken parts in place so that the magnet can retain its magnetic attraction force while the escape of loose pieces is effectively prevented. Accordingly, it is submitted that new claim 21 is patentable over Miller and allowance of this new claim is respectfully asked.

An earnest effort having been made to answer each of the examiner's rejections, it is submitted that, as amended herein, each of the remaining claims 1-3, 5-16 and 18-21 is in condition for allowance and the allowance thereof is respectfully asked.

Respectfully submitted,

Emrich & Dithmar  
Attorneys for Applicants  
Suite 3000  
300 South Wacker Drive  
Chicago, Illinois 60606  
Telephone 312-663-9800

By: *Jerry Stratman*